

REMARKS

I. Status of the Claims

Claims 1, 5, 7 and 8 are currently being amended.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Upon entry of this Amendment, claims 1-12 will remain pending in the application.

Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

II. Response to Election of Species Requirement

In response to the Election of Species Requirement, Applicants hereby make the following election, as described below:

The Examiner states that all of the pending claims, claims 1-12, fall into one group, Group 1. However, the Examiner asserts that the claims are directed to more than one species of the generic invention. The Examiner asserts that the species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under Rule 13.1.

Applicants elect, with traverse, the species wherein Xaa¹ is His, Xaa² is Trp, and Xaa³ is Tyr (i.e., SEQ ID NO: 6). The Examiner is reminded that a species election is solely for search purposes and that should the elected species be free of the prior art, the Examiner will follow the procedure in M.P.E.P. 803.02 and extend the search to the other species.

Applicants traverse the Election of Species Requirement because the international examination report does not formally raise a lack of unity objection. According to the PCT Handbook, Section 33.35 (Exhibit A), a designated/elected office should not raise an objection as to lack of unity (Rule 13 PCT) when the International Examination Authority has found that the claims comply with this requirement.

Furthermore, Applicants respectfully assert that all peptides within SEQ ID NO: 7 share the same inventive concept. SEQ ID NO: 7 defines a very small number of peptides

and all of the defined peptides are active (*see, e.g.*, Example 2, last line and Example 3, last line) and are suitable for use in the treatment of osteoporosis.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

By Gwe Z #46,785

for Stephen A. Bent
Attorney for Applicant
Registration No. 29,768

33.35 Unity of invention in the national phase

One of the matters which may be considered by designated Offices in the national phase is whether the claims are directed to more than one invention. If a designated or elected Office considers that a finding by the International Searching or Preliminary Examining Authority that there is a lack of unity of invention is justified and the applicant did not pay the additional search or examination fee in response to the Searching or Examining Authority's invitation, the unsearched or unexamined claims may be considered withdrawn unless the applicant pays a special fee to the designated or elected Office (Articles 17(3)(b) and 34(3)(c) PCT). This could presumably, national law permitting, give the applicant the opportunity to pursue the unsearched or unexamined claims before the designated Office, instead of the searched or examined claims or to have a national search or examination conducted against the claims unsearched or unexamined in the international phase prior to deciding whether to file a divisional application at the designated Office.

The PCT Contracting States have agreed to follow the practice under the Patent Cooperation Treaty on unity of invention (as to which see para. 23.9). Therefore, a designated Office ought not to raise an objection as to a lack of unity when the International Searching and/or Preliminary Examining Authority has found that the claims comply with the requirement for unity of invention (Rule 13 PCT). When the issue of unity of invention has been raised in the international phase and a protest against an invitation to pay additional search or examination fees has been upheld (paras 29.13 and 34.34 respectively), the applicant can ask the International Searching or Preliminary Examining Authority, as the case may be, for copies of the decision on the protest to be supplied to the designated Offices. A translation of such decision should accompany any prescribed translation of the international application itself (paras 33.7 and 33.16).

33.36 Non-prejudicial disclosures

Many national laws contain provisions for excluding certain disclosures of an invention before the filing date or before the priority date of a national patent application from consideration when deciding whether that invention as claimed in the national application meets the criteria for patentability, having regard to the prior art. Such disclosures are usually called "non-prejudicial disclosures" or "exceptions to lack of novelty". Depending on the national law, a non-prejudicial disclosure might be a disclosure without the consent of the applicant (a wrongful disclosure or an "evident abuse"), a disclosure of the invention at an exhibition, especially an international exhibition within the terms of the 1928 Convention on International Exhibitions, as amended, or a disclosure of the invention by or with the consent of the inventor or the applicant within a grace period. Such non-prejudicial disclosures are mentioned in the 1963 Strasbourg Convention on Unification, Articles 4(4) and 12(1)(b).